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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,793	02/04/2000	David J. Baillargeon	10213-1	9309

7590 04/01/2002

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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
1764	9

DATE MAILED: 04/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/498,793	BAILLARGEON ET AL.
	Examiner	Art Unit
	Ellen M McAvoy	1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 17 January 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-4 and 6-43 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 and 6-43 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trewella et al (6,090,989).

Applicants' arguments filed 17 January 2002 have been fully considered but they are not persuasive. As set forth in the previous office action, Trewella et al ["Trewella"] disclose a liquid hydrocarbon composition containing paraffinic hydrocarbon components in which the extent of branching, as measured by the percentage of methyl hydrogens (BI), and the proximity of branching, as measured by the percentage of recurring methylene carbons which are four or more carbons removed from an end group or branch ( $\text{CH}_2 > 4$ ) are such that: (a)  $\text{BI} - 0.5(\text{CH}_2 > 4) > 15$ ; and (b)  $\text{BI} + 0.85(\text{CH}_2 > 4) < 45$  as measured over said liquid hydrocarbon composition as a whole.

See column 3, lines 5-38. Trewella teaches that the liquid hydrocarbon composition may additionally contain effective amounts of lubricating oil additives such as antioxidants, anti-wear additives, friction modifiers, viscosity index improvers, detergents, etc. See column 3, lines 39-57. The paraffinic hydrocarbon composition of Trewella may be used in combination with other lubricating oil basestocks such as mineral oils, polyalphaolefins, esters, etc. See column 5, lines 37-42. In the response filed 17 January 2001, applicants amended independent claim 1, the only independent claim in the application, to recite that the liquid lubricant composition have "a pour

point of from about  $-25^{\circ}\text{C}$  to  $-55^{\circ}\text{C}$  and a viscosity index of 130 to 160" and argue that the present claims are directed to lubricant compositions which are formulated using paraffinic basestocks which may be within the scope of the Trewella disclosure but which form a more limited sub-class within the broader class described by Trewella. Applicants argue that the paraffinic wax isomerates used in the presently claimed lubricant compositions are defined in terms which include their viscosity index and their pour point, both of which jointly contribute to the production of finished lubricant compositions which have properties, including biodegradability, which are not found in nor reasonably could have been predicted from Trewella. This is not deemed to be persuasive of patentability because Trewella actually *prefers* the narrower range of lubricant compositions now claimed by applicants. Trewella teaches that the liquid hydrocarbon composition is characterized by extremely low pour points of less than or equal to  $-18^{\circ}\text{C}$ , preferably less than or equal to  $-30^{\circ}\text{C}$  and more preferably less than or equal to  $-40^{\circ}\text{C}$ , with kinematic viscosities ranging from about 2.0 cSt to greater than about 13 cSt at  $100^{\circ}\text{C}$ , preferably about 4 cSt to about 8 cSt at  $100^{\circ}\text{C}$ , and with high viscosity indices (VI) of about 130-165, preferably from about 140-165 and more preferably from about 150-165. See column 6, lines 1-15. In Table 1, column 8, Trewella sets forth properties of basestocks of the invention which meet the new limitations of the claims; example 9 shows a basestock with a kinematic viscosity at  $100^{\circ}\text{C}$  of 5.46 cSt, a VI of 144 and a pour point of  $-40^{\circ}\text{C}$  and example 10 shows a basestock with a kinematic viscosity at  $100^{\circ}\text{C}$  of 7.9 cSt, a VI of 157 and a pour point of  $-42^{\circ}\text{C}$ . These appear to be closest prior art examples. Thus, the examiner maintains the position that Trewella meets the limitations of the liquid lubricant compositions of applicants'

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claims. Although the property of biodegradability is not set forth, the examiner maintains the position that since the paraffinic basestock of the prior art may be the same as applicants' paraffinic basestock, the degree of biodegradability may and most likely is the same. It has been well decided that something which is old does not become patentable upon the discovery of a new property. The claiming of an unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

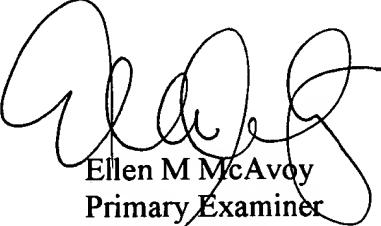
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
March 28, 2002